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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/007,205	11/09/2001	William T. Wilkinson	WIL-102US	3554

31344 7590 04/19/2005

RATNERPRESTIA
P.O. BOX 1596
WILMINGTON, DE 19899

EXAMINER

PARDO, THUY N

ART UNIT	PAPER NUMBER
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2165

DATE MAILED: 04/19/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/007,205

Applicant(s)

WILKINSON, WILLIAM T.

Examiner

Thuy Pardo

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 27 December 2004.
2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-22 is/are pending in the application.
4a) Of the above claim(s) _____ is/are withdrawn from consideration.
5) ☐ Claim(s) _____ is/are allowed.
6) ☒ Claim(s) 1-22 is/are rejected.
7) ☐ Claim(s) _____ is/are objected to.
8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
10) ☒ The drawing(s) filed on 09 November 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

f

DETAILED ACTION

1. Applicant's Amendment filed on December 12, 2004 has been reviewed. Claims 1, 7 and 15 have been amended, and claim 22 has been added.

2. Claims 1-22 are presented for examination.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

3. Claims 1-22 are rejected under 35 U.S.C. 102(e) as being anticipated by Magid US Patent Application No. 2001/0032144.

As to claim 1, Magid teaches the invention substantially as claimed, comprising:

providing a comprehensive, centralized network of members, including one or more service provider members [sellers, 0029 of page 2], each member having expertise in at least one facet of IP commercialization [sellers and purchasers who make use of the network central to market intellectual property, 0033 of pages 2-3];

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offering an interested party access to the network [see fig. 2; 0041-0046 of pages 3-4];
and

service provider members of the network [intellectual property marketing firms, 0004; 0034] providing services to the interested party [offer the purchaser a full disclosure of the technology, 0058 of page 4; 3-7 of fig. 2], the service selected from a group consisting of: prior art search services; legal services; financial services, prototyping services; model making services; manufacturing; testing services; industrial design services; commercial art services; marketing services; IP valuation services for assigning tangible value to IP assets; IP audit services; services that provide R&D project analysis, evaluation, or both; insurance services, security analysis services; and management consulting services [perform the technology management, 0019; legal service, 0034; security, 0044].

As to claim 2, Magid teaches the invention substantially as claimed. Magid further teaches collecting data relating to at least said one aspect of IP [inherent in the system]; and disseminating said data to at least said interested party [3-6, 3-7 of fig. 2].

As to claim 3, Magid teaches the invention substantially as claimed. Magid further teaches ranking information identifying, classifying, comparing, ranking and evaluating one or more IP assets, entities that own or control IP, or sources of IP, and the method further comprises compiling said ranking information [0013 of page 1].

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As to claim 4, Magid teaches the invention substantially as claimed. Magid further teaches using said ranking information to recognize innovation by presenting awards to top ranked entities [0014 of page 1].

As to claim 5, Magid teaches the invention substantially as claimed. Magid further teaches that the interested party is also a member of the network [using username and password in order to enter the system, fig. 2b].

As to claim 6, Magid teaches the invention substantially as claimed. Magid further teaches that the members of the comprehensive network comprise inventors, government entities, research and development (R&D) and manufacturing entities, IP specialists, providers of business services, and IP marketplace providers [0014 of page 1].

As to claim 7, Magid teaches the invention substantially as claimed. Magid further teaches that the services provided by the network further comprise IP valuation services for assigning tangible value to IP assets [0013; 0014; 0031].

As to claim 8, Magid teaches the invention substantially as claimed. Magid further teaches creating a financial market for IP assets where IP assets, or securities based upon IP assets, can be bought and sold [0043 of page 3].

As to claim 9, Magid teaches the invention substantially as claimed. Magid further teaches providing a certification program for certifying IP analysts qualified to provide tangible valuation of IP assets [0045-0065 of pages 3-5].

As to claim 10, Magid teaches the invention substantially as claimed. Magid further teaches providing an educational program comprising education in accounting, financial, legal, and actuarial skills for educating individuals how to provide tangible valuation of IP assets [0034 of page 3].

As to claim 11, Magid teaches the invention substantially as claimed. Magid further teaches providing a trade show in which a plurality of the service providers exhibit information to others about the services offered by the service providers [0007-0013 of page 1].

As to claim 12, Magid teaches the invention substantially as claimed. Magid further teaches the facet of IP commercialization in which each member has expertise corresponds to a step in a natural life cycle of an IP asset, the trade show having a physical layout organized with the service providers grouped together according to step in the IP asset life cycle [see fig. 2].

As to claim 13, Magid teaches the invention substantially as claimed. Magid further teaches that the service providers are grouped into legal service providers, business service providers, pre-market service providers, commercialization service providers, and after-market service providers [inherent in the system].

As to claim 14, Magid teaches the invention substantially as claimed. Magid further teaches a dedicated marketplace for buying, selling, auctioning, and bidding on IP assets [fig. 2].

As to claims 15-17, all limitations of these claims have been addressed in the analysis above, and these claims are rejected on that basis.

As to claim 18, Magid teaches the invention substantially as claimed. Magid further teaches that the access to the network is provided by means of a global computer network or by telephone [0031-0033 of pages 1-2].

As to claim 19, Magid teaches the invention substantially as claimed. Magid further teaches providing a dedicated site on the global computer network accessible by the interested party; providing computerized means for digitally receiving a request for information about one or more service provider members from the interested party; providing a database of records relating to the service provider members searchable by the computerized means in response to the request for information; and providing the requested information to the interested party [fig. 2; 0031-0033 of pages 2-3].

As to claim 20, Magid teaches the invention substantially as claimed. Magid further teaches receiving characterizing information pertaining to the interested party, and matching a

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service provider member to the interested party based upon the characterizing information [fig. 2].

As to claim 21, Magid teaches the invention substantially as claimed. Magid further teaches information selected from the group consisting of type of IP about which the interested party desires the information, subject area of the IP, and the geographic region of the interested party [0014 of page 1].

As to claim 22, Magid teaches the invention substantially as claimed. Magid further teaches that services provided by the service providers include IP valuation services for assigning tangible value to IP assets [0013; 0014; 0031].

Response to Arguments

4. Applicant argues that only subject matter disclosed in the Magid Provisional Application filed on January 11, 2000 can be considered as a potential prior art against the Applicant's application.

Examiner respectfully disagrees. Examiner believes that the Magid Patent application Publication filed October 18, 2001 is still qualified as a prior art against Applicant's Application for those limitations, which have not been addressed in the Provisional Application filed November 09, 2000, but added in on the filing date November 09, 2001, and the Magid Provisional Application filed on January 11, 2000 can be qualified as a potential prior art against the Applicant's application for only limitations which have been addressed in the Provisional

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Application filed November 09, 2000. Since the Applicant's Provisional Application differs from the Applicant's Application, Applicant is required to provide a fact sheet to distinguish limitations addressed in the Provisional Application filed November 09, 2000 from limitations added on in the Application filed November 09, 2001. Examiner will use the Magid Patent Application and the Magid Provisional Application to match up with those limitations based on that fact sheet.

Applicant argues that nothing in Magid teaches or suggest other services desirable for commercialization of IP could be provided.

As to this point, Examiner respectfully disagrees. Examiner believes that Magid teaches these limitations. Magid teaches services relating to the marketing or exchange of intellectual property including to assistance with capital sourcing, marketing consultation, new/bulletin board services, and legal services (see 0034).

Applicant argues Magid does not teach assigning tangible value to IP assets.

Applicant respectfully disagrees. Examiner also believes that Magid teaches this limitation of assigning tangible value to IP assets [0013; 0014; 0031].

5. Applicant's arguments filed December 27, 2005 have been fully considered but they are not persuasive.

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Thuy Pardo, whose telephone number is 571-272-4082. The examiner can normally be reached Monday through Thursday from 8:30 AM to 5:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Dov Popovici, can be reached at 571-272-4083.

The fax phone number for the organization where this application or proceeding is assigned are as follows: (703) 872-9306 (Official Communication)

and/or:

571-273-4082 (*Use this Fax#, only after approval by Examiner, for "INFORMAL" or "Draft" communication. Examiner may request that a formal/amendment be faxed directly to then on occasions*).

Any inquiry of a general nature of relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 305-3900.

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7. Any response to this action should be mailed to:

Commissioner of Patents and Trademarks

Washington, D.C. 20231

or faxed to:

(703) 308-9051, (for formal communications intended for entry)

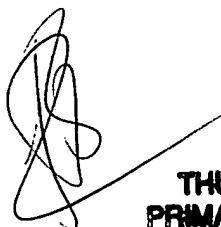
Or:

(703) 308-5359, (for informal or draft communications, please label

"PROPOSED" or "DRAFT")

Hand-delivered responses should be brought to Crystal Park II, 2121 Crystal
Drive, Arlington. VA., Sixth Floor (Receptionist).

April 15, 2005

A handwritten signature in black ink, appearing to be 'Thuy N. Pardo', written over a horizontal line.

**THUY N. PARDO
PRIMARY EXAMINER**